

DEC 13 2005

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December 13, 2005

VIA FACSIMILE - 4 PAGES (Including This Cover)

Commissioner for Patents
POB 1450, Alexandria, VA 22313-1450
Transmitted to USPTO Central Fax No. 571-273-8300


Applicants: NAKAYAMA et al
Serial No.: 09/940,638
Filed: August 29, 2001
For: Electroluminescent Film Device
Art Unit: 2813
Examiner: Pham, T.
Atty Docket: 500.40580X00

Sir:

Applicant hereby transmits the attached "Petition for Withdrawal of Finality of Outstanding Office Action (3 pages)" regarding the above-identified application.

CERTIFICATE OF TRANSMISSION:

I hereby certify that the attached "Petition for Withdrawal of Finality of Outstanding Office Action (3 pages)" are being **FORMALLY TRANSMITTED** via the USPTO Central Fax No. 571-273-8300 on **13 December 2005**.


Alan E. Schiavelli

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: NAKAYAMA et al
Serial No.: 09/940,638
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For: Electroluminescent Film Device
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PETITION FOR WITHDRAWAL OF FINALITY OF OUTSTANDING OFFICE ACTION

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

December 13, 2005

Sir:

Applicants hereby petition to withdraw the finality of the Office Action mailed April 19, 2005, in connection with the above-identified application.

Applicants requested reconsideration of the finality in the Amendment After Final filed October 19, 2005, and, in the Advisory Action mailed November 7, 2005, the Examiner maintained the finality of the April 19, 2005 Office Action. Since Applicants have made a proper request for reconsideration and the action by the Examiner has been repeated, this petition is proper under 37 C.F.R. 1.181.

Under present examination practice, a second or subsequent action on the merits can be made final except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. 1.97(c) with the fees set forth in 37 C.F.R. 1.117(p). Manual of Patent Examining Procedure (MPEP) 706.07(a). The Office Action of

April 19, 2005 introduces a new ground of rejection that was neither necessitated by Applicants' amendment of the claims nor based on information submitted in an information disclosure statement.

As admitted by the Examiner in the numbered section 6 of the Office Action, the Office Action contains new grounds of rejection. At least some of these grounds were not necessitated by amendment. For example, the objection to claim 1 in numbered section 1 of the Office Action and the rejection of claims 1, 2-6, 8-18, 21 and 22 under 35 U.S.C. 112, second paragraph in numbered section 2 of the Office Action were not necessitated by amendment since the phrases now deemed by the Examiner to lack antecedent basis and to render the claims indefinite were present in the claims prior to the Amendment of January 7, 2005. Accordingly, the Amendment of January 7, 2005 did not necessitate these grounds of rejections. Therefore, the finality of the outstanding Office Action is premature and should be withdrawn.

In the Advisory Action, the Examiner alleges that the final rejection included a new ground of rejection based on a new scope of amended claims, including amended independent claim 1. Presumably, the Examiner is referring to the prior art rejections in numbered sections 3 and 4 of the Office Action. However, whether or not the prior art rejections were necessitated by Applicants' Amendment is irrelevant. The fact remains that the Office Action introduced a new ground of rejection (at least the rejection of the claims under 35 U.S.C. 112, second paragraph) that was neither necessitated by Applicants' amendment of the claims nor based on information submitted in an information disclosure statement. Therefore, the finality of the Office Action is premature and should be withdrawn. Upon withdrawal of the finality of the

Office Action, the Amendment filed October 19, 2005 must be entered and a new Office Action issued by the Examiner.

Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 500.40580X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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